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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,846	08/07/2000	Dave Frederickson	12368/79201	3409

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EXAMINER

SIMONE, CATHERINE A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 01/30/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-4

Office Action Summary

Application No.

09/633,846

Applicant(s)

FREDERICKSON ET AL.

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 26-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15 and 35-49, drawn to a method for making a coated strap, classified in class 427, subclass 458+.
 - II. Claims 16-25, drawn to a corrosion-resistant coated and cured strap, classified in class 428, subclass 156.
 - III. Claims 26-34, drawn to a strap base material coating apparatus, classified in class 118, subclass 621+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed in Invention II can be made by another and materially different process without the steps of the Group I process i.e. conveying a metal strap along a conveyance path through a coating apparatus etc.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as

Art Unit: 1772

claimed in Invention I can be practiced by another materially different apparatus without the specifics of the Group III apparatus i.e. a powdered coating spray region etc.

Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed in Invention II can be made by another and materially different apparatus without the specifics of the Group III apparatus i.e. a conveyance path etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mitch Weinstein on January 3, 2002 a provisional election was made without traverse to prosecute the invention of a corrosion-resistant coated and cured strap, claims 16-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 and 26-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 20-25** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "mils" in **claims 20-25** is deemed vague and indefinite. The recitation "mils" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Clarification is requested.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 16-18** are rejected under 35 U.S.C. 102(b) as being anticipated by Levine (4,601,958).

Levine discloses a corrosion-resistant strap (see col. 2, lines 18-20) comprising a metal strap base element (see col. 2, line 35), the metal strap base element (Fig. 2, #12) having a width and a thickness defining first and second sides and a pair of edge regions (see Fig. 2); and a cured powder coating (gold) on the base element, the coating having a substantially consistent thickness at the first and second sides and at the edge regions (see col. 4, lines 4-17). Regarding **claim 17**, the coating has a greater thickness at about the edge regions and on the first and

Art Unit: 1772

second sides adjacent the edge regions defining a dog-bone profile (see col. 4, lines 38-40).

Regarding **claim 18**, the coating is inherently a melted and cured powder.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 19-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine (4,601,958).

Regarding **claim 19**, Levine discloses the claimed invention except for the powder coating being of an epoxy material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Levine's powder coating with an epoxy material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding **claims 20-25**, Levine discloses the claimed invention except for the coating having a thickness of about 0.2 mils to about 5.0 mils. The optimum range of the coating thickness would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided Levine's coating with a thickness of about 0.2 mils to about 5.0 mils, since it has been held that where the general conditions of a claim are

Art Unit: 1772

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents are cited for further teachings of metal straps similarly to that instantly disclosed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CAS
Catherine Simone
Examiner
Art Unit 1772

January 25, 2002


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/25/02